

Thomas B. Blackburn, et al.
U.S. Application No. 10/723,961
Filed: November 26, 2003
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REMARKS

This application has been reviewed in light of the Office Action dated December 19, 2005. Claims 256-272 are now pending and under consideration.

Rejection Under 35 U.S.C. § 112, Second Paragraph.

The Examiner rejected claim 257 under 35 U.S.C., §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner alleges that Claim 257 is indefinite because claim 257 depends from a canceled claim (claim 1). Applicants respectfully disagree and note that claim 257 depends on pending claim 256 (see listing of claims in September 16, 2005 Amendment). Accordingly, Applicants respectfully request that this rejection be withdrawn.

Objections Under 37 CFR 1.75

The Examiner has objected to claims 268 and 269 for alleging being substantial duplicates of claim 267. The Examiner alleged that the claims 268 and 269 "cover the same thing, despite a slight difference in wording".

Applicants disagree that the claims are duplicative. Claim 267 is drawn to a pharmaceutical composition comprising a therapeutically effective amount of the compound of claim 256 and a pharmaceutically acceptable carrier (Emphasis added). Claim 268 is drawn to a pharmaceutical composition made by combining a therapeutically effective amount of the compound of claim 256 and a pharmaceutically acceptable carrier (Emphasis added). Claim 269 recites a process for

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making a pharmaceutical composition comprising combining a therapeutically effective amount of the compound of claim 256 and a pharmaceutically acceptable carrier.

Claim 267 recites a pharmaceutical composition (a product) and is silent as to how the composition was prepared. Claim 268 recites a pharmaceutical composition made by a specified process (i.e., a product-by-process claim) and claim 269 recites a process of manufacture. A sale of the pharmaceutical composition recited in claim 267 *would infringe* claim 267, *may infringe* claim 268 depending on the method of manufacture used to prepare the pharmaceutical composition, and *would not infringe* claim 269. Accordingly, Applicants maintain that claims 268 and 269 cannot be deemed duplicative of claim 267 because they do not "cover the same thing" as evidenced by the fact that the three claims are not infringed by the mere fact that one of the claims is infringed. Applicants respectfully request that this objection be withdrawn.

Information Disclosure Statement

On page 3 of the December 19, 2005 Office Action the Examiner acknowledged receipt of the Information Disclosure Statements filed June 3 and October 28, 2004. The Examiner then stated that the citations under "other documents" filed on June 3, 2004 were crossed off for allegedly not being proper publication *per se* having a publication date that comply with the requirements of 37 CFR 1.97 and 1.98 (emphasis in original).

Applicants note that the following publications were crossed off the Form PTO-1449 which accompanied the June 4, 2004 Information Disclosure Statement:

Bionet Research Ltd. Catalog #11L-312S (1-Phenyl-3-([3-trifluoromethyl]phenyl)imino)-1,3-dihydro-2H-indol-2-one);

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U.S. Serial No. 10/006, 343, filed December 3, 2001; and

U.S. Serial No. 10/007,132, filed December 3, 2001.

Applicants note the two applications pending above were subsequently published as United States Published Patent Application Numbers 2003/0119096 and 2003/0027254, respectively. Applicants enclose herewith a PTO SB08(a) form which lists the two published applications recited above. Accordingly, Applicants respectfully request that the PTO/SB/08(a) form be initialed and returned, indicating that the cited documents have been considered.

In the Supplemental Information Disclosure Statement which was filed on June 1, 2004 in connection with the captioned application, John P. White, the attorney of record, stated, "[the] [P]irst sale by Bionet is understood to have occurred on January 5, 1998". Applicants were unable to ascertain the exact publication date of the Bionet Research Ltd. Catalog, listed hereto on PTO SBO8(b) form; however, Applicants' prior attorney did ascertain that the catalog published prior to the effective filing date of the captioned application. Accordingly, Applicants respectfully request that the PTO/SB/08(b) form be initialed and returned, indicating that the cited document has been considered.

Applicants maintain that no fee is due in connection with the filing of this Information Disclosure Statement since the three references were previously cited to the Examiner. However, if a fee is deemed necessary, authorization is hereby given to charge the amount of any such fee to Deposit Account Number 501358.

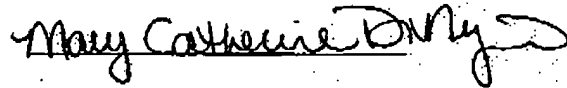
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Conclusion

In view of the foregoing, Claims 256-272 are submitted to be allowable, and issuance of a formal Notice of Allowance is respectfully solicited.

Respectfully submitted,



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March 21, 2006

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